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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,250	12/22/2004	Gilbert Robert Bernard Germaine	TS5575US	9713
7590 Jennifer D Adamson Shell Oil Company Intellectual Property PO Box 2463 Houston, TX 77252-2463			EXAMINER BOYER, RANDY	
			ART UNIT 1764	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,250

Applicant(s)

GERMAINE, GILBERT ROBERT
BERNARD

Examiner

Randy Boyer

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :
22 December 2004 and 9 August 2007 .

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I (claims 1-4) in the reply filed on 9 August 2007 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 5 and 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed 9 August 2007.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benazzi (WO 01/81508 A1) in view of Biscardi (US 6579441).
6. With respect to claims 1 and 4, Benazzi discloses a process for the preparation of medicinal white oil from a paraffinic distillate bottom product (see Benazzi, Abstract; page 2, lines 21-22; and page 15, lines 28-29), wherein the paraffinic distillate bottom product is obtained by a process comprising: (a) hydrocracking/hydroisomerizing a liquid hydrocarbon feed (see Benazzi, page 6, lines 4-9), wherein the feed contains at least 20% boiling volume above 340°C (see Benazzi, page 3, lines 32-34; and page 4, line 1); (b) separating the product of step (a) into one or more distillate fractions of lower boiling fractions and a broad range base oil precursor fraction and a heavy fraction such that the T90 wt% boiling point of the base oil precursor fraction is between 350°C and 550°C (see Benazzi, page 8, lines 21-31); (c) performing a pour point reducing step to the broad range base oil precursor fraction obtained in step (b) (see Benazzi, page 10, lines 15-20; page 12, line 5; and page 13, lines 2-8); and (d) isolating a heavy bottom distillate fraction by distilling the product of step (c) (see Benazzi, page 14, lines 15-21).

Benazzi does not specify wherein the liquid hydrocarbon feedstock is "a Fischer-Tropsch derived paraffinic distillate bottom product," wherein the weight ratio of compounds having at least 60 or more carbon atoms and compounds having at least 30 carbon atoms in the liquid hydrocarbon feedstock is at least 0.2 and wherein at least 30

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wt% of compounds in the liquid hydrocarbon feed have at least 30 carbon atoms; or wherein the bottom product is contacted with a heterogeneous adsorbent.

However, Benazzi discloses that the liquid hydrocarbon feedstock is only limited to the extent that it contain at least 20% boiling volume above 340°C (see Benazzi, page 3, lines 32-34; and page 4, line 1). Otherwise, Benazzi provides an exhaustive, though non-exclusive, list of example feedstocks that includes vacuum distillates. Thus, Examiner finds Benazzi's disclosure to be sufficiently broad to encompass hydrocarbon feedstocks that are "Fischer-Tropsch derived paraffinic distillate bottom products," wherein the weight ratio of compounds having at least 60 or more carbon atoms and compounds having at least 30 carbon atoms in the liquid hydrocarbon feedstock is at least 0.2 and wherein at least 30 wt% of compounds in the liquid hydrocarbon feed have at least 30 carbon atoms. In addition, Biscardi discloses a process by which haze precursors are removed from base oils by contacting such oils with a heterogeneous adsorbent (see Biscardi, Abstract; column 3, lines 66-67; and column 4, lines 1-9). Biscardi explains that his process is most preferably used following a catalytic dewaxing process (e.g. step (c) of Benazzi) since haze precursors tend to be more abundant in oil that has been catalytically dewaxed (see Biscardi, column 5, lines 1-12). Specifically, Biscardi notes that a preferred base oil feed for contacting with the adsorbent generally boils above 260°C and has a viscosity, measured at 100°C, of at least 2.0 cSt (see Biscardi, column 5, lines 15-19) (e.g. the base oil obtained by the process of Benazzi, which boils at a temperature above 340°C and has a viscosity of at least 3.0 cSt at 100°C (see Benazzi, page 14, lines 15-29)).

Therefore, the person having ordinary skill in the art of processes for the preparation of medicinal and/or technical white oils would have been motivated to combine the process of Benazzi with the adsorption treatment process of Biscardi in order to remove any haze precursors remaining in the catalytically dewaxed base oil produced by Benazzi's process.

Finally, the person having ordinary skill in the art of processes for the preparation of medicinal and/or technical white oils would have had a reasonable expectation of success in combining the process of Benazzi with that of Biscardi because: (1) both Benazzi and Biscardi are directed to the production and/or upgrading of white oils; (2) Biscardi explicitly contemplates the use of his process in combination with an upstream catalytic dewaxing process (e.g. step (c) of the process of Benazzi); and (3) Biscardi discloses the use of a preferred base oil feedstock to be treated having the same characteristics as that of the base oil produced in the process of Benazzi.

7. With respect to claim 2, Biscardi discloses wherein the adsorbent comprises active carbon (see Biscardi, column 7, lines 50-59).

8. With respect to claim 3, Benazzi discloses wherein a medicinal white oil is obtained having a kinematic viscosity at 100°C of more than 3.0 cSt (see Benazzi, page 14, lines 26-29), a non-cyclic paraffins content of greater than 80 wt% (see Benazzi, page 15, lines 20-22), a Saybolt color of greater than +30 (see Benazzi, page 16, lines 19-21), UV adsorption spectra values of less than 0.60 in the 290-299 nm spectral band and less than 0.40 in the 300-329 nm spectral band (see Benazzi, page 16, lines 3-7).


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Boyer whose telephone number is (571) 272-7113. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola, can be reached at (571) 272-1444. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RPB


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